

REMARKS

Applicants respectfully request reconsideration and allowance of all pending claims.

I. Status of the Claims

In this Amendment C, claim 45 has been amended and claim 50 has been cancelled, in order to more particularly claim certain embodiments herein. Accordingly, claims 34, 37-49 and 51-53 remain pending.

II. Withdrawn Claims

It is noted that the final Office Action indicates that claims 37-44 have been withdrawn from consideration by the Examiner "as being drawn to a non-elected invention/species." In response thereto, Applicants respectfully point out that

- (A) upon careful review of the prosecution history of the present application, Applicants cannot find **any** indication that a Restriction Requirement or an Election of Species requirement was **ever** issued by the Office; and,
- (B) the withdrawn claims have **already been subjected to substantive examination** by the Office (see the Office action dated December 23, 2008), and no amendments to these claims were made in response thereto.

In view of the foregoing, Applicants submit the Office's withdrawal of claims 37-44 was improper, and therefore further submit that these claims should remain pending and under examination herein.

III. Allowable Subject Matter

Applicants acknowledge that claims 51-53 are allowable. Applicants further acknowledge that claims 47 and 48 are objected to as dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

IV. Rejection of Claims under 35 U.S.C. §112, Second Paragraph

Claims 45 and 46 have been rejected as indefinite under 35 U.S.C. § 112, second paragraph. For the reasons set forth in detail below, Applicants respectfully request reconsideration of these rejections.¹

A. Claim 45

The Office has rejected claim 45 as indefinite, specifically on the basis that the phrase 'slight excess' is a relative phrase and will vary from person to person absent a definition set forth in the specification. Without commenting on the accuracy or the appropriateness of the Office's rejection here, Applicants have amended claim 45 to remove the word "slight," in order to expedite examination and allowance of all pending claims. The claim has also been amended to delete the phrase "at 37°C" and inserted the text "incubation for." Support may be found in Example 3. Applicants therefore respectfully request withdrawal of this rejection.

B. Claim 46

Claim 46 has been rejected as indefinite because, according to the Office, some of the specific species recited within this claim show a halogen substituent at X₁, X₂ or X₃, and halogens are not permissible substituents in view of base claim 34. In response thereto, Applicants respectfully request reconsideration.

Claim 34, from which claim 46 directly depends, states in relevant part that:

at least two of X₁, X₂ and X₃ are monodentate ligands selected from the group consisting of CO, NH₃, aromatic heterocycles, thioethers and isocyanides; or

two of X₁, X₂ and X₃ are part of a bidentate ligand and the other one is a monodentate ligand selected from the group consisting of CO, aromatic heterocycles, thioethers and isocyanides.

Thus, it is to be noted that while the second clause clearly excludes the possibility of X₁, X₂ or X₃ being a halogen atom (because they are either part of a bidentate ligand or selected from the species in the recited Markush group), the first clause **does not**. Specifically, while the "at least two" phrase of the first clause clearly means that, in some embodiments, all three of X₁, X₂ and X₃ will be monodentate ligands selected from the species referenced in the Markush group, this phrase also means that, in other embodiments, **only two** of X₁, X₂ and X₃ will be monodentate

¹ Inasmuch as claim 50 has been cancelled in this Amendment C, the substance of the Office's rejection of this claim need not be addressed at this time.

ligands selected from the referenced species. In the case of the latter embodiments, one of X_1 , X_2 and X_3 can be a different ligand, such as a halogen atom, as further illustrated in claim 46.

In view of the foregoing, Applicants respectfully submit that claim 46 fully satisfies the requires of 35 U.S.C. §112, second paragraph; that is, claim 46 particularly points out and distinctly claims the subject matter Applicants regard as their invention. Applicants therefore request reconsideration and withdrawal of the present rejection.

V. Rejection of Claims under 35 U.S.C. § 102(b)

Claims 34 and 49 are rejected under 35 U.S.C. § 102(b) as anticipated by Dyszlewski *et al.* (Molecular Imaging, January 2002, Vol. 1, pages 24-35, hereinafter referred to as "Dyszlewski"). Specifically, the Office cites figure 1, page 25, and notes that the "species of Dyszlewski *et al* encompass the instant invention when Z1 (sic), X2, and X3 are isocyanides and M is Tc or Re." (See the present Office action on page 6, first and second full paragraphs, as well as the middle chemical structure in the first row of Figure 1).

In response thereto, Applicants respectfully point out that the noted compound disclosed by Dyszlewski does not encompass the instant invention; stated another way, the subject matter of claim 34, from which claim 49 depends, does not read on the subject matter disclosed by Dyszlewski in general, and the noted compound disclosed by Dyszlewski in particular. The compound disclosed in Dyszlewski includes nitrile substituents, wherein the carbon atom of the CN ligand is bound to the metal (*i.e.*, $M-C\equiv N$). In contrast, claim 34 references, in relevant part, Isocyanide substituents, wherein the nitrogen atom of the CN is bound to the metal (*i.e.*, $M-N\equiv C$). As a result, substituting a nitrile in place of an isocyanide does not give the same compound. Furthermore, in addition to their structural differences, these two substituents are also different in terms of their properties, syntheses, and/or reaction behaviors.

In view of the foregoing, Applicants respectfully point out that Dyszlewski does not teach each and every limitation of the claimed invention. Applicants therefore respectfully submit that claim 34, as well as claim 49 depending therefrom, are not anticipated by Dyszlewski. Accordingly, reconsideration of the present rejection is requested.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and allowance of all pending claims.

The Commissioner is hereby authorized to charge Deposit Account No. 13-1160 for any fees that may be required for this Amendment C.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Anthony R. Kinney", is written over a horizontal line.

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VIA EFS